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**Gates & Cooper LLP**Howard Hughes Center  
6701 Center Drive West, Suite 1050  
Los Angeles, California 90045**FAX TRANSMISSION TO USPTO**TO: Commissioner for Patents  
Attn: Examiner Fred I. Ehichioya  
Patent Examining Corps  
Facsimile Center  
Alexandria, VA 22313-1450FROM: George H. Gates  
OUR REF.: SVL920050710US1  
TELEPHONE: (310) 642-4146Total pages, including cover letter: 27PTO FAX NUMBER: **571-273-8300**

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Title of Document Transmitted:	TRANSMITTAL SHEETS AND REQUEST FOR RECONSIDERATION OF THE DECISION ON THE APPLICATION FOR PATENT TERM ADJUSTMENT WITH EXHIBITS A AND B.
Applicant:	Jane W. Chang et al.
Serial No.:	09/827,500
Filed:	April 6, 2001
Group Art Unit:	2162
Title:	WIRELESS INFORMATION RETRIEVAL
Our Ref. No.:	SVL920050710US1

Please charge all fees to Deposit Account No. 09-0460 of IBM Corporation, the assignee of the present application.

By: Name: George H. Gates  
Reg. No.: 33,500

I hereby certify that this paper is being transmitted by facsimile to the U.S. Patent and Trademark Office on the date shown below.

  
SignatureOctober 30, 2006  
Date

GHG/bjs

G&amp;C 30571.321-US-01

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Jane Wen Chang et al.	Examiner:	Fred I. Ehichioya
Serial No.:	09/827,500	Group Art Unit:	2162
Filed:	April 6, 2001	Docket:	SVL920050710US1
Title:	WIRELESS INFORMATION RETRIEVAL		

## CERTIFICATE OF MAILING OR TRANSMISSION UNDER 37 CFR 1.8

I hereby certify that this correspondence is being filed via facsimile transmission to the U.S. Patent and Trademark Office on October 30, 2006.

By: FAH/T3  
Name: George H. Gates

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

We are transmitting herewith the attached:

- ☒ Transmittal sheet, in duplicate, containing a Certificate of Mailing or Transmission under 37 CFR 1.8.
- ☒ Request for Reconsideration of the Decision on the Application for Patent Term Adjustment with Exhibits A and B.

Please consider this a **PETITION FOR EXTENSION OF TIME** for a sufficient number of months to enter these papers, if appropriate.

Please charge all fees to Deposit Account No. ~~09-0460 of IBM Corporation~~, the assignee of the present application. A duplicate of this paper is enclosed.

Customer Number 45729  
GATES & COOPER LLP  
Howard Hughes Center  
6701 Center Drive West, Suite 1050  
Los Angeles, CA 90045  
(310) 641-8797

By: FAH/T3  
Name: George H. Gates  
Reg. No.: 33,500  
GHG/bjs

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Applicant:	Jane Wen Chang et al.	Examiner:	Fred I. Ehichioya
Serial No.:	09/827,500	Group Art Unit:	2162
Filed:	April 6, 2001	Docket:	SVL920050710US1
Title:	WIRELESS INFORMATION RETRIEVAL		

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I hereby certify that this correspondence is being filed via facsimile transmission to the U.S. Patent and Trademark Office on October 30, 2006.By: [Signature]  
Name: George H. GatesCommissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

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Customer Number 45729  
GATES & COOPER LLP  
Howard Hughes Center  
6701 Center Drive West, Suite 1050  
Los Angeles, CA 90045  
(310) 641-8797

By: [Signature]  
Name: George H. Gates  
Reg. No.: 33,500  
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T-272 P.004 F-687

OCT 30 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Jane Wen Chang et al.	Examiner:	Fred I. Ehichioya
Serial No.:	09/827,500	Group Art Unit:	2162
Filed:	April 6, 2001	Docket:	SVL920050710US1
Title:	WIRELESS INFORMATION RETRIEVAL		

## CERTIFICATE OF MAILING OR TRANSMISSION UNDER 37 CFR 1.8

I hereby certify that this correspondence is being transmitted by facsimile to the United States Patent and Trademark Office on October 30, 2006.

By: 

Name: George H. Gates

REQUEST FOR RECONSIDERATION OF THE DECISION  
ON THE APPLICATION FOR PATENT TERM ADJUSTMENT

Mail Stop ISSUE FEE  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

I. Introduction

Applicants' attorney submits this Request for Reconsideration of the Decision on the Application for Patent Term Adjustment dated October 11, 2006. Attached hereto as Exhibit A is a copy of the Decision.

Applicants' attorney respectfully submits that the Office erred in charging 301 days of delay against Applicants for the time period from 02-27-2004 through 12-20-2004. Consequently, it is submitted that the Decision should have granted additional days of patent term adjustment, and it is requested that such additional days of patent term adjustment be granted upon reconsideration.

II. Basis for the Request for Reconsideration

The facts, analysis and conclusion in the Decision misinterpret certain critical events, which are set forth below and documented in the attached Exhibits:

- 02-23-2004 – The Transaction History of PAIR states “Non-Final Rejection.” There is no corresponding entry in the Image File Wrapper of PAIR.

- 02-27-2004 – The Transaction History of PAIR states “Mail Non-Final Rejection.” There is no corresponding entry in the Image File Wrapper of PAIR.
- 10-06-2004 – The Transaction History of PAIR states “Case Docketed to Examiner in GAU.” There is no corresponding entry in the Image File Wrapper of PAIR.
- 12-02-2004 – The Transaction History of PAIR states “Correspondence Address Change.” There is no corresponding entry in the Image File Wrapper of PAIR.
- 12-02-2004 – The Transaction History of PAIR states “Letter Restarting Period for Response (i.e., Letter re: References.” There is no corresponding entry in the Image File Wrapper of PAIR.
- 12-20-2004 – The Transaction History of PAIR states “Mail Notice of Restarted Response Period.” There are corresponding entries in the Image File Wrapper of PAIR, namely “Non-Final Rejection” (attached hereto as Exhibit B), “List of references cited by examiner,” and “List of References cited by applicant and considered by examiner.”

It appears that the “Mail Non-Final Rejection” dated 02-27-2004 was mailed to the wrong address. It also appears that this error was recognized by the PTO on 12-02-2004, which is the date that a “Correspondence Address Change” was entered, but without any submission by the Applicants.

This conclusion is supported by the “Mail Notice of Restarted Response Period” dated 12-20-2004. However, as shown in Exhibit B, the actual document mailed was a “Non-Final Rejection,” not a “Notice of Restarted Response Period.”

Note that page 1 of the Office Action is dated 12-20-2004 and shows the correct correspondence address (namely, an address for the law firm of Fish & Richardson P.C.), but page 2 of the Office Action is dated 02-27-2004 and has an erroneous address (namely, an address for MetaEdge Corporation). (See pages 12 and 13 of Exhibit B). This indicates that the Non-Final Rejection dated 02-27-2004 was mailed by the PTO to the wrong address, which later recognized its error.

Indeed, had the Non-Final Rejection dated 02-27-2004 been mailed to the correct address, or even if the PTO merely believed the Non-Final Rejection dated 02-27-2004 had been mailed to the correct address, the time period for responding would have expired on 08-27-2004 and the application would have been abandoned for failure to respond within the time period of the Non-Final Rejection dated 02-27-2004.

No such abandonment occurred, most likely because the PTO recognized this error as being its own error. Indeed, no Notice of Abandonment was mailed to the Applicants and no response to such a Notice (such as a Petition for the Withdrawal of the Holding of Abandonment) was made by the Applicants. Instead, an address changed was entered on 12-02-2004 without any submission by the Applicants, apparently by the PTO to correct the error, and the PTO then mailed the Non-Final Rejection on 12-20-2004, although it labeled the transaction as "Mail Notice of Restarted Response Period," even though nothing in Exhibit B indicates that this is a restarted response period. Indeed, note that page 3 of the Office Action dated 12-20-2004 states the document is "[r]esponsive to the communication(s) filed 12 January 2004," which was the last response submitted by the Applicants. (See page 14 of Exhibit B).

The facts, therefore, support the conclusion that the delay from 02-27-2004 to 12-20-2004 should be charged against the PTO, not the Applicants. Consequently, Applicants' attorney submits that the PTO erred in its calculation of the patent term adjustment, by charging the Applicants with a delay of 301 days for failure to timely respond to a Non-Final Rejection dated 02-27-2004, when, in fact, the delay was solely due to an error by the PTO.

In conclusion, Applicants' attorney requests reconsideration of the Decision on the Application for Term Adjustment.

No fee is deemed necessary in connection with the filing of this Request. However, should the Office determine that a fee is required, the Office is authorized to charge any such fee to Deposit Account No. 09-0460 of IBM Corporation, the assignee of the present application.

Respectfully submitted,

Jane Wen Chang et al.

By their attorneys,

GATES & COOPER LLP

6701 Center Drive West, Suite 1050  
Los Angeles, California 90045  
(310) 642-4146

Dated: October 30, 2006

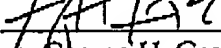
By:   
Name: George H. Gates  
Reg. No.: 33,500

EXHIBIT A



## UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No.

GATES & COOPER LLP  
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SUITE 1050  
LOS ANGELES CA 90045

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OCT 02 2006

OFFICE OF PETITIONS

In re Application of	:	
Chang et al.	:	DECISION ON APPLICATION
Application No. 09/827,500	:	FOR
Filed: April 6, 2001	:	PATENT TERM ADJUSTMENT
Atty Docket No. 103594.00002	:	

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT IN NOTICE OF ALLOWANCE UNDER 37 C.F.R. § 1.705(b)," filed June 6, 2006. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from zero (0) days to four hundred sixty-four (464) days.

The application for patent term adjustment is GRANTED to the extent indicated herein.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the notice of allowance is **two hundred sixty-three (263)** days. A copy of the updated PAIR screen, showing the correct determination, is enclosed,

On March 9, 2006, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 0 days. On June 6, 2006, applicants timely submitted the instant application for patent term adjustment<sup>1</sup>. Applicants assert entitled to a period of adjustment of 222 days for the Office taking until December 20, 2004, not February 27,

<sup>1</sup> PALM records indicate that the Issue Payment was filed on June 9, 2006.



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Application No. 09/827,500

2004, to respond to their amendment filed January 12, 2004. Further, applicants dispute the reduction of 301 days for their filing of a response to the non-final Office action mailed February 27, 2004 (and re-mailed on December 20, 2004) on March 24, 2005.

Applicants state that the application is not subject to a terminal disclaimer.

Applicants' arguments have been considered, but not found fully persuasive. Entry of a period of adjustment of 222 days is not warranted. A review of the application history confirms that in response to and within four months of applicants' filing of an amendment after non-final Office action on January 12, 2004, the Office on February 27, 2004 mailed a non-final Office action. This Office action was properly mailed to the correspondence address of record. However, applicants did not receive the Office action. The record does not support a conclusion that the failure to receive the Office action was due to any error on the part of the Office. (A copy of the first page of the Office action as originally mailed is present in the image file wrapper with the contents of the re-mailed Office action mailed December 20, 2004). Thus, there was no examination delay within the meaning of 1.702(a)(2).

Correction of the period of reduction for responding to the Office action is required. As the Office action was not received, the Office action was re-mailed and the period for reply restarted (The entry "Mail Notice of Restarted Response Period" reflects that the original Office action was re-mailed with a new response period). Applicants' delay pursuant to 1.704(b) is properly calculated based on the date of re-mailing of the Office action, December 20, 2004. Accordingly, the period of reduction pursuant to 1.704(b) for applicants taking until March 24, 2005 to respond is 4 days, not 301 days.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the notice of allowance is 263 days.

Receipt of the \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fees are required.

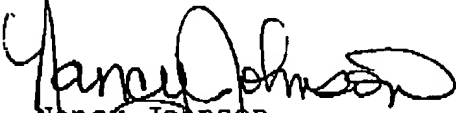
The application is being forwarded to the Office of Patent Publication for issuance of the patent. The patent term

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Page 3

adjustment indicated on the patent will include any additional patent term adjustment accrued for Office delay in issuing the patent after payment of the issue fee and all outstanding requirements having been met.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.



Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions

Enclosure: Copy of REVISED PAIR Screen

Day : Sunday  
Date: 10/1/2006

Time: 18:14:23

**PALM INTRANET**

PTA Calculations for Application: 09/827500					
Application Filing Date:		04/06/2001	PTO Delay (PTO):		298
Issue Date of Patent:			Three Years:		0
Pre-Issue Petitions:		0	Applicant Delay (APPL):		332
Post-Issue Petitions:		0	Total PTA (days):		263
PTO Delay Adjustment:		297			

File Contents History					
Number	Date	Contents Description	PTO	APPL	START
85	09/29/2006	ADJUSTMENT OF PTA CALCULATION BY PTO		4	
84	09/29/2006	ADJUSTMENT OF PTA CALCULATION BY PTO	301		
75	03/09/2006	MAIL NOTICE OF ALLOWANCE			
74	03/09/2006	MAIL EXAMINER'S AMENDMENT			
73	03/06/2006	ISSUE REVISION COMPLETED			
72	03/06/2006	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
71	03/06/2006	EXAMINER'S AMENDMENT COMMUNICATION			
70	03/06/2006	NOTICE OF ALLOWABILITY			
69	09/11/2005	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
68	02/17/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
67	02/17/2006	REFERENCE CAPTURE ON IDS			
66	02/17/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
65	03/02/2006	DATE FORWARDED TO EXAMINER			
64	02/17/2006	REQUEST FOR CONTINUED EXAMINATION (RCE)			
63	03/02/2006	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
62	02/21/2006	RECORD PETITION DECISION OF GRANTED TO WITHDRAW FROM ISSUE			
61	02/17/2006	WORKFLOW - REQUEST FOR RCE - BEGIN			
60	02/17/2006	PETITION ENTERED			
59	02/07/2006	EXPORT TO FINAL DATA CAPTURE			
58	02/03/2006	FINISHED INITIAL DATA CAPTURE			
57	02/03/2006	DISPATCH TO FDC			

56	12/29/2005	MISCELLANEOUS INCOMING LETTER			
55	01/13/2006	APPLICATION IS CONSIDERED READY FOR ISSUE			
54	12/29/2005	ISSUE FEE PAYMENT VERIFIED			
53	12/29/2005	STATEMENT FILED INDICATING A LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS			
52	12/29/2005	ISSUE FEE PAYMENT RECEIVED			
51	12/13/2005	CORRESPONDENCE ADDRESS CHANGE			
50	10/11/2005	EXPORT TO INITIAL DATA CAPTURE			
49	10/04/2005	MAIL NOTICE OF ALLOWANCE			
48	10/04/2005	MAIL EXAMINER'S AMENDMENT			
47	09/30/2005	ISSUE REVISION COMPLETED			
46	09/30/2005	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
45	09/30/2005	EXAMINER'S AMENDMENT COMMUNICATION			
44	09/30/2005	NOTICE OF ALLOWABILITY			
43	09/11/2005	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
42	09/23/2005	PRELIMINARY AMENDMENT			
41	09/08/2005	DATE FORWARDED TO EXAMINER			
40	08/24/2005	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
39	09/08/2005	DATE FORWARDED TO EXAMINER			
38	08/24/2005	REQUEST FOR CONTINUED EXAMINATION (RCE)			
37	09/08/2005	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
36	08/24/2005	WORKFLOW - REQUEST FOR RCE - BEGIN			
35	07/18/2005	CORRESPONDENCE ADDRESS CHANGE			
34	06/16/2005	MAIL FINAL REJECTION (PTOL - 326)			
33	06/13/2005	FINAL REJECTION			
32	04/06/2005	DATE FORWARDED TO EXAMINER			
31	03/24/2005	RESPONSE AFTER NON-FINAL ACTION		301	24
30	03/24/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
29	12/29/2003	REFERENCE CAPTURE ON IDS			
28	12/20/2004	MAIL NOTICE OF RESTARTED RESPONSE PERIOD			
27	12/02/2004	LETTER RESTARTING PERIOD FOR RESPONSE (I.E. LETTER RE: REFERENCES)			

26	12/02/2004	CORRESPONDENCE ADDRESS CHANGE			
25	10/06/2004	CASE DOCKETED TO EXAMINER IN GAU			
24	02/27/2004	MAIL NON-FINAL REJECTION			
23	02/23/2004	NON-FINAL REJECTION			
21	01/22/2004	DATE FORWARDED TO EXAMINER			
20	01/12/2004	RESPONSE AFTER NON-FINAL ACTION			
19	12/29/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
18	12/12/2003	MAIL NON-FINAL REJECTION			
17	12/09/2003	NON-FINAL REJECTION			
16	11/25/2003	DATE FORWARDED TO EXAMINER			
15	11/14/2003	AMENDMENT AFTER FINAL REJECTION		31	13
14	11/14/2003	REQUEST FOR EXTENSION OF TIME - GRANTED			
13	07/14/2003	MAIL FINAL REJECTION (PTOL - 326)			
12	07/11/2003	FINAL REJECTION			
11	07/01/2003	DATE FORWARDED TO EXAMINER			
10	06/24/2003	RESPONSE AFTER NON-FINAL ACTION			
9	03/31/2003	MAIL NON-FINAL REJECTION	298		-1
8	03/24/2003	NON-FINAL REJECTION			
7	03/10/2003	CASE DOCKETED TO EXAMINER IN GAU			
6	06/06/2002	NEW OR ADDITIONAL DRAWING FILED			
5	07/06/2001	CASE DOCKETED TO EXAMINER IN GAU			
4	05/14/2001	APPLICATION DISPATCHED FROM OIPE			
3	05/11/2001	CORRESPONDENCE ADDRESS CHANGE			
2	04/19/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	04/06/2001	INITIAL EXAM TEAM NN			

Search Another: Application#

EXPLANATION OF PTA CALCULATIONEXPLANATION OF PTE CALCULATION

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EXHIBIT B



## UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, Virginia 22313-1450  
www.uspto.gov

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OCT 30 2006

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,500	04/06/2001	Jane Wen Chang	11646-013001	5732
7390 12/20/2004				
Fisher & Richardson P.C. 225 Franklin Street Boston, MA 02110				
EXAMINER BRICHIOVA, FRED I				
ART UNIT		PAPER NUMBER		
2162				

DATE MAILED: 12/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1600  
Alexandria, Virginia 22312-1400  
www.uspto.gov

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OCT 30 2006

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,500	04/06/2001	Jane Wen Chang	11646-013001	5732

7590 02/27/2004  
MetaEdge Corporation  
5201 Great America Parkway  
Suite 238  
Santa Clara, CA 95054

EXAMINER

EHICHIOYA, FRED I

ART UNIT

PAPER NUMBER

2172

DATE MAILED: 02/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



## Office Action Summary

Application No.

09/827,500

Applicant(s)

CHANG ET AL

Examiner

Fred I. Ehichioya

Art Unit

2172

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 - 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No.(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No.(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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Application/Control Number: 09/827,500  
Art Unit: 2172

Page 2

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments, with respect to claims 1 – 30, filed 12 January 2004 have been fully considered but they are not persuasive for the following reasons.
2. Applicants argue: "Alleva fails to teach, suggest or even mention a query or outputting a prose rendition of the query." (Page 2, Para 4)

In response to Applicants' argument: the argument is moot in view of the new ground(s) of rejection with USPN 6,601,026.

Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the specification.

#### Interpretation of Claims-Broadest Reasonable Interpretation

During patent examination, the pending claims must be 'given the broadest reasonable interpretation consistent with the specification.' Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969).

Applicants clearly state on Page 2, lines 20 – 23 of the specification that "Outputting the prose rendition may include processing the query in conjunction with rules of grammar and processing the query in conjunction with prose configuration file."

Application/Control Number: 09/827,500  
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The query processing of Khan combined with Appelt's teaching of "The grammar can comprise pattern-action rules, or it can comprise one or more rules to specify a proper noun, a complex word, a phrase, as well as a domain event. The grammar can also comprise one or more rules for merging partial information from different parts of a document. The index for the text corpus can be searched using natural language querying. The natural language querying can be based on a query grammar. The query grammar can be associated with a topic. The query grammar can be represented as pattern action-rules." (column 3, lines 8 -17) clearly suggest outputting prose rendition.

3. Applicant's arguments with respect to claims 1 - 30 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 7 – 12, 14, and 25 - 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,338,575 issued to Khan et al. (hereinafter "Khan") in view of U.S. Patent 6,601,026 issued to Douglas E. Appelt et al (hereafter "Appelt").

Regarding claims 1, 14, 29 and 30, Khan teaches a method of accessing information comprising:

processing a query and a wireless identifier received from a wireless devices (see column 2, lines 4 – 34 and column 16, lines 25 – 29);

searching a collection of data for a set of results matching the query (see column 10, lines 44 – 50); and

outputting the subset of results on the wireless device (see column 10, lines 13 – 26 and column 11, lines 1 – 3).

Khan does not explicitly teach selectively reducing the set of results to generate a subset of results; and outputting a prose rendition of the query.

Appelt teaches selectively reducing the set of results to generate a subset of results (see column 3, lines 20 - 25);

outputting a prose rendition of the query (see column 3, lines 1 - 35).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine teaching of Appelt with the teaching of Khan wherein the query can be represented as pattern-action rules. The motivation is that the invention is easy to use since it does not require users to learn cryptic search syntax associated with the search criteria.

Regarding claims 7 and 25, Khan teaches selectively reducing comprises:  
placing the set of results in a hierarchical data structure organized by taxonomy (see column 24, lines 18 – 46);  
discarding results positioned at a lowest level of the hierarchical data structure (see column 23, lines 64 – 67).

Regarding claim 8, Appelt teaches outputting the prose rendition comprises:  
processing the query in conjunction with rules of grammar (see column 3, lines 14 - 17); and  
processing the query in conjunction with a prose configuration file (see column 2, lines 21 – 29).

Regarding claim 9, Khan teaches outputting of the subset comprises placing the subset in a table (see column 23, lines 4 – 9).

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Regarding claim 10, Khan teaches customizing the table to the wireless device  
(see column 10, lines 64 - 65).

Regarding claim 11, Khan teaches customizing the table to the wireless device  
comprises:

loading a wireless style sheet database (see column 11, lines 1 - 3);  
locating a style sheet that matches the wireless identifier in the style sheet  
database (see column 11, lines 3 - 6); and  
reducing the length and width of the table in accordance with the style sheet (see  
column 10, lines 13 - 19).

Regarding claims 12 and 27, Khan teaches wherein reducing further comprises  
subdividing the table into a plurality of smaller tables (see column 25, lines 2 - 3).

Regarding claim 26, Khan teaches outputting the subset comprises:  
placing the subset in a table ("see column 23, lines 4 - 9); and  
reducing the length and width of the table in accordance with the style sheet (see  
column 10, lines 13 - 19).

Regarding claim 28, Khan teaches outputting the subset comprises replacing  
long form words in the table with corresponding abbreviations in an abbreviations  
database (see column 25, lines 23 - 30).

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6. Claims 2 – 6, 13, and 15 - 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,338,575 issued to Khan in view of Appelt and further in view of U.S. Patent 6,505,158 issued to Allstair D. Conkie (hereafter "Conkie").

Regarding claims 2 and 20, Khan and Appelt disclose the claimed subject matter as discussed in claims 1 and 14 respectively. Khan teaches processing the query comprises:

adding context to the search fragment (see column 10, lines 42 - 43).

Khan or Appelt does not explicitly teach parsing the query to generate a search fragment; substituting long form words for abbreviations contained in the search fragment in conjunction with an abbreviations dictionary.

Conkie teaches parsing the query to generate a search fragment (see column 3, line 22 and column 4, lines 65 – 67);

substituting long form words for abbreviations contained in the search fragment in conjunction with an abbreviations dictionary (see column 3, lines 34 – 41).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine teaching of Conkie with the teaching of Khan and Appelt wherein the words are parsed to generate the fragments. The motivation is that parsing articulates the way words or phrased are used.

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Regarding claims 3 and 21, Khan teaches adding context comprises extracting data from a web page from which the query was received (see column 23, lines 58 – 60; where "extracting data from a web page" is read on "the user is then allowed to select the headline or hyperlink of his/her choice").

Regarding claims 4 and 22, Khan teaches adding context comprises extracting data from a previously presented results page from which the query was received (see column 22, lines 53 – 59).

Regarding claims 5 and 23, Khan and Appelt disclose the claimed subject matter as discussed in claim 1 and 12 respectively.

Conkie teaches processing the query comprises:

normalizing text of the query (see column 3, lines 22 - 25);

parsing the text (see column 3, line 22);

associating long form words for abbreviations in conjunction with an abbreviations dictionary (see column 3, lines 25 - 41); and

providing meaning to the text (see column 3 lines 29 - 34).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine teaching of Conkie with the teaching of Khan and Appelt wherein the words are parsed to generate the fragments. The motivation is that parsing articulates the way words or phrased are used.



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Regarding claims 6 and 24, Conkie teaches associating context with the text (see column 4, lines 56 – 59).

Regarding claim 13, Khan and Appelt disclose the claimed subject matter as discussed in claim 10. Appelt teaches customizing the table comprises:

loading an abbreviations dictionary (see column 3, lines 39 - 51).

Khan or Appelt does not explicitly teach replacing long form words in the table with corresponding abbreviations in the abbreviations.

Conkie teaches replacing long form words in the table with corresponding abbreviations in the abbreviations (see column 3, lines 22 – 41).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine teaching of Conkie with the teaching of Khan and Appelt wherein the words are parsed to generate the fragments. The motivation is that parsing articulates the way words or phrased are used.

Regarding claim 15, Conkie teaches the query is a combination of text, sentence fragments and abbreviated words (see column 3, lines 20 - 67).

Regarding claim 16, Conkie teaches the query is text (see column 3, lines 24 - 25).

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Regarding claim 17, Conkie teaches the query is sentence fragments (see column 4, line 4).

Regarding claim 18, Conkie teaches the query is abbreviated words (see column 3, lines 22 - 25).

Regarding claim 19, Conkie teaches the query is speech (see column 2, lines 4 - 6).

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred I. Ehichioya whose telephone number is 703-305-8039. The examiner can normally be reached on M - F 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 703-305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Fred I. Ehichioya  
Examiner  
Art Unit 2172  
February 12, 2004

  
SHAHID ALAM  
PRIMARY EXAMINER

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